

ESTTA Tracking number: **ESTTA649519**

Filing date: **01/12/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Equinox Holdings, Inc.
Granted to Date of previous extension	01/11/2015
Address	895 Broadway New York, NY 10003 UNITED STATES
Attorney information	Keith Medansky DLA Piper LLP (US) P.O. Box 64807 Chicago, IL 60664-0807 UNITED STATES ch.tm@dlapiper.com, keith.medansky@dlapiper.com, tracy.zawaski@dlapiper.com

### Applicant Information

Application No	77305284	Publication date	07/15/2014
Opposition Filing Date	01/12/2015	Opposition Period Ends	01/11/2015
Applicant	Raffles International Limited #10-00 Raffles City Tower Singapore, 179101 SINGAPORE		

### Goods/Services Affected by Opposition


Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Business management of food outlets and beverage outlets; business management consulting services relating to food outlets and beverage outlets; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in the field of foods and beverages; advisory and consulting services relating to all the aforesaid services
Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Provision of banqueting services and food and beverage facilities; cafes, bars, cocktail lounges, restaurants, bistro, brasserie and coffee shops and services relating to the foregoing, namely providing food and drink; food preparation services; carry-out and take-out restaurant services; provision of food and drink catering services at meetings, conferences, conventions, exhibitions and social functions; hotel catering services; consulting services in the field of hospitality and/or culinary arts

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Other	Lack of bona fide intention to use
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## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1796108	Application Date	08/23/1991
Registration Date	09/28/1993	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1991/06/00 First Use In Commerce: 1991/06/00 health club services		


U.S. Registration No.	1903842	Application Date	09/15/1992
Registration Date	07/04/1995	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1992/09/01 First Use In Commerce: 1992/09/01 education services; namely, conducting seminars and classes in the fields of physical fitness, exercise and nutrition		

U.S. Registration No.	3118571	Application Date	05/15/1996
Registration Date	07/25/2006	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1994/12/31 First Use In Commerce: 1994/12/31 educational services, namely providing courses of instruction to personal trainers in the field of fitness, health and wellness Class 042. First use: First Use: 1994/12/31 First Use In Commerce: 1994/12/31 physical fitness consultations; rendering of physical therapy services		


U.S. Registration	3722700	Application Date	09/30/1992
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No.			
Registration Date	12/08/2009	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1992/01/01 First Use In Commerce: 2000/01/01 Clothing, namely, shirts, tank tops, sweat shirts, gym shorts, shorts, pants, underwear and hats		

U.S. Registration No.	1900162	Application Date	06/10/1992
Registration Date	06/13/1995	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1991/12/31 First Use In Commerce: 1991/12/31 spa services		


U.S. Registration No.	4169576	Application Date	06/16/2007
Registration Date	07/10/2012	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	The mark consists of oval with the word "EQUINOX" written in black and white letters with an elliptical broken oval circle placed on an angle over the main oval.		
Goods/Services	Class 035. First use: First Use: 1991/09/30 First Use In Commerce: 1991/12/31 Retail stores featuring a wide range of fitness related goods, namely, clothing, swimwear and accessories, footwear, hats, gloves, athletic bags, sports equipment, heart rate monitors		


U.S. Registration No.	4173317	Application Date	06/16/2007
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Registration Date	07/17/2012	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1991/09/30 First Use In Commerce: 1991/12/31 Retail stores featuring a wide range of fitness related goods, namely clothing, swimwear and accessories, footwear, hats, gloves, athletic bags, sports equipment, heart rate monitors		


U.S. Registration No.	3542543	Application Date	06/16/2007
Registration Date	12/09/2008	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2004/09/30 First Use In Commerce: 2004/09/30 General purpose bags for carrying yoga equipment; All-purpose athletic bags		

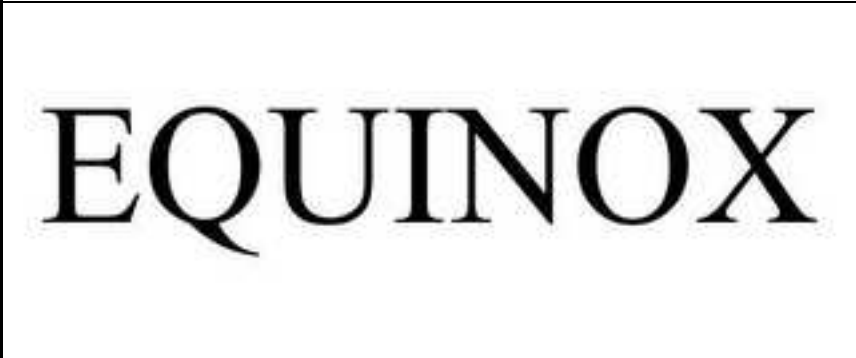
U.S. Registration No.	3542542	Application Date	06/16/2007
Registration Date	12/09/2008	Foreign Priority Date	NONE
Word Mark	EQUINOX		


Design Mark	
Description of Mark	The mark consists of oval with the word"EQUINOX" written in the oval with an elliptical broken oval circle placed on anangle over the main oval.
Goods/Services	Class 018. First use: First Use: 2004/09/30 First Use In Commerce: 2004/09/30 All-purpose athletic bags; General purpose bags for carrying yoga equipment

U.S. Registration No.	3377795	Application Date	05/30/2007
Registration Date	02/05/2008	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	The mark consists of oval that is half black and half white with the word EQUI-NOX written in black and white letters with an elliptical broken oval circle placed on an angle over the main oval.		
Goods/Services	<p>Class 041. First use: First Use: 1991/09/30 First Use In Commerce: 1991/09/30 Physical fitness conditioning classes; Providing fitness and exercise facilities; Personal training services, namely, strength and conditioning training; Health club services, namely, providing instruction and equipment in the field of physical exercise; Educational services, namely, conducting courses in the field of health and wellness</p> <p>Class 044. First use: First Use: 1991/09/30 First Use In Commerce: 1991/12/31 Providing wellness services, namely, personal assessments, personalized routines, maintenance schedules, and counseling; Nutrition counseling; Physical therapy; Health spa services, namely, cosmetic body care services; Bodywork</p>		

	therapy; Massage
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U.S. Registration No.	4505526	Application Date	05/24/2007
Registration Date	04/01/2014	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	<p>The mark consists of an oval broken into two sections; the left section is black and the right section is white. On the oval is the word "EQUINOX" with the letters "EQU" in white, the letters "NOX" in black, and the letter "I" in both black and white. Surrounding this is an elliptical broken oval in white placed on an angle. The other black in the mark represents background and is not claimed as a feature of the mark.</p>		
Goods/Services	Class 032. First use: First Use: 2008/08/31 First Use In Commerce: 2008/08/31 Bottled drinking water		

U.S. Registration No.	4510967	Application Date	05/22/2007
Registration Date	04/08/2014	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 2013/08/31 First Use In Commerce: 2013/08/31 Bottled drinking water		

U.S. Registration No.	4038763	Application Date	05/21/2007
Registration Date	10/11/2011	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 044. First use: First Use: 1991/09/30 First Use In Commerce: 1991/09/30 Health spa services, namely, cosmetic body care services</p> <p>Class 045. First use: First Use: 2007/12/31 First Use In Commerce: 2007/12/31 Concierge services for others comprising making requested personal arrangements and reservations and providing customer-specific information to meet individual needs rendered together in a residential complex, home, online or otherwise</p>		

U.S. Registration No.	2074971	Application Date	08/15/1995
Registration Date	07/01/1997	Foreign Priority Date	NONE
Word Mark	EQUINOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 1995/03/31 First Use In Commerce: 1995/03/31 newsletters containing articles relating to health and fitness which are distributed at health clubs and spas</p>		

Attachments	74197463#TMSN.png( bytes ) 77207987#TMSN.png( bytes ) 77207988#TMSN.png( bytes ) 77207991#TMSN.png( bytes ) 77207990#TMSN.png( bytes ) 77192750#TMSN.png( bytes ) 77189292#TMSN.png( bytes ) 77187555#TMSN.png( bytes ) 77186607#TMSN.png( bytes ) 74715627#TMSN.png( bytes ) Notice of Opp EQUINOX.pdf(182982 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/TLZ/
Name	Tracy L. Zawaski
Date	01/12/2015



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

EQUINOX HOLDINGS, INC.,	)	
	)	
Opposer,	)	Opposition No. _____
	)	
v.	)	Mark: EQUINOX
	)	
RAFFLES INTERNATIONAL LIMITED,	)	Serial No.: 77/305,284
	)	
Applicant.	)	Filing Date: October 16, 2007
	/	

**NOTICE OF OPPOSITION**




Equinox Holdings, Inc. (“Opposer”), a Delaware corporation with an address at 895 Broadway, New York, New York 10003, United States of America, believes that it is being and will be damaged by the registration of the mark EQUINOX in Application Serial No. 77/305,284 and opposes the same.



The grounds for the opposition are as follows:

1. Since at least as early as 1991, Opposer has used the trade name and mark EQUINOX (the “EQUINOX Mark”) in U.S. commerce in connection with a wide range of goods and services. Opposer’s goods and services under the EQUINOX mark include physical fitness and health club services, and other goods and services such as nutrition counseling, spa services, cafes, restaurants, food and juice bars, bottled beverages and apparel (“Opposer’s Goods and Services”). In addition, Opposer has used the name “Equinox” as a trade name.

2. Opposer is the owner of numerous trademark registrations for the EQUINOX Mark, including, without limitation, the following registrations:

Mark	Reg. No.	Application Date	Goods and Services	Registration Date	Status
EQUINOX	1796108	August 23, 1991	INT. CL. 41 HEALTH CLUB SERVICES	September 28, 1993	Registered

Mark	Reg. No.	Application Date	Goods and Services	Registration Date	Status
EQUINOX	1903842	September 15, 1992	<b>INT. CL. 41</b> EDUCATION SERVICES; NAMELY, CONDUCTING SEMINARS AND CLASSES IN THE FIELDS OF PHYSICAL FITNESS, EXERCISE AND NUTRITION	July 4, 1995	Registered
EQUINOX	3118571	May 15, 1996	<b>INT. CL. 41</b> EDUCATIONAL SERVICES, NAMELY PROVIDING COURSES OF INSTRUCTION TO PERSONAL TRAINERS IN THE FIELD OF FITNESS, HEALTH AND WELLNESS <b>INT. CL. 42</b> PHYSICAL FITNESS CONSULTATIONS; RENDERING OF PHYSICAL THERAPY SERVICES	July 25, 2006	Registered
EQUINOX	3722700	September 30, 1992	<b>INT. CL. 25</b> CLOTHING, NAMELY, SHIRTS, TANK TOPS, SWEAT SHIRTS, GYM SHORTS, SHORTS, PANTS, UNDERWEAR AND HATS	December 8, 2009	Registered
EQUINOX	1900162	June 10, 1992	<b>INT. CL. 42</b> SPA SERVICES	June 13, 1995	Registered
	4169576	June 16, 2007	<b>INT. CL. 35</b> RETAIL STORES FEATURING A WIDE RANGE OF FITNESS RELATED GOODS, NAMELY, CLOTHING, SWIMWEAR AND ACCESSORIES, FOOTWEAR, HATS, GLOVES, ATHLETIC BAGS, SPORTS EQUIPMENT, HEART RATE MONITORS	July 10, 2012	Registered
EQUINOX	4173317	June 16, 2007	<b>INT. CL. 35</b> RETAIL STORES FEATURING A WIDE RANGE OF FITNESS RELATED GOODS, NAMELY CLOTHING, SWIMWEAR AND ACCESSORIES, FOOTWEAR, HATS, GLOVES, ATHLETIC BAGS, SPORTS EQUIPMENT, HEART RATE MONITORS	July 17, 2012	Registered
EQUINOX	3542543	June 16, 2007	<b>INT. CL. 18</b> GENERAL PURPOSE BAGS FOR CARRYING YOGA EQUIPMENT; ALL-PURPOSE ATHLETIC BAGS	December 9, 2008	Registered
	3542542	June 16, 2007	<b>INT. CL. 18</b> ALL-PURPOSE ATHLETIC BAGS; GENERAL PURPOSE BAGS FOR CARRYING YOGA EQUIPMENT	December 9, 2008	Registered
	3377795	May 30, 2007	<b>INT. CL. 41</b> PHYSICAL FITNESS CONDITIONING CLASSES; PROVIDING FITNESS AND EXERCISE FACILITIES; PERSONAL TRAINING SERVICES, NAMELY, STRENGTH AND CONDITIONING TRAINING; HEALTH CLUB SERVICES, NAMELY, PROVIDING INSTRUCTION AND EQUIPMENT IN THE FIELD OF PHYSICAL EXERCISE; EDUCATIONAL SERVICES, NAMELY, CONDUCTING COURSES IN THE FIELD OF HEALTH AND WELLNESS <b>INT. CL. 44</b> PROVIDING WELLNESS SERVICES, NAMELY, PERSONAL ASSESSMENTS, PERSONALIZED ROUTINES, MAINTENANCE SCHEDULES, AND COUNSELING; NUTRITION COUNSELING;	February 5, 2008	Registered

Mark	Reg. No.	Application Date	Goods and Services	Registration Date	Status
			PHYSICAL THERAPY; HEALTH SPA SERVICES, NAMELY, COSMETIC BODY CARE SERVICES; BODYWORK THERAPY; MASSAGE		
	4505526	May 24, 2007	INT. CL. 32 BOTTLED DRINKING WATER	April 1, 2014	Registered
EQUINOX	4510967	May 22, 2007	INT. CL. 32 BOTTLED DRINKING WATER	April 8, 2014	Registered
EQUINOX	4038763	May 21, 2007	INT. CL. 44 HEALTH SPA SERVICES, NAMELY, COSMETIC BODY CARE SERVICES INT. CL. 45 CONCIERGE SERVICES FOR OTHERS COMPRISING MAKING REQUESTED PERSONAL ARRANGEMENTS AND RESERVATIONS AND PROVIDING CUSTOMER-SPECIFIC INFORMATION TO MEET INDIVIDUAL NEEDS RENDERED TOGETHER IN A RESIDENTIAL COMPLEX, HOME, ONLINE OR OTHERWISE	October 11, 2011	Registered
	2074971	August 15, 1995	INT. CL. 16 NEWSLETTERS CONTAINING ARTICLES RELATING TO HEALTH AND FITNESS WHICH ARE DISTRIBUTED AT HEALTH CLUBS AND SPAS	July 1, 1997	Registered

(collectively, the “EQUINOX Registrations”).

3. On information and belief, Raffles International Limited (“Applicant”) is a Singapore corporation with an address at #10-00 Raffles City Tower, 250 North Bridge Road, Singapore 179101.

4. On October 16, 2007, Applicant filed an intent-to-use application, Application Serial No. 77/305,284, to register the mark EQUINOX for “business management of food outlets and beverage outlets; business management consulting services relating to food outlets and beverage outlets; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in the field of foods and beverages; advisory and consulting services relating to all the aforesaid services” in Class 35, and “provision of banqueting services and food and beverage facilities; cafes, bars, cocktail lounges, restaurants, bistro, brasserie

and coffee shops and services relating to the foregoing, namely providing food and drink; food preparation services; carry-out and take-out restaurant services; provision of food and drink catering services at meetings, conferences, conventions, exhibitions and social functions; hotel catering services; consulting services in the field of hospitality and/or culinary arts” in Class 43 (“Applicant’s Application”).

5. Opposer has established common-law rights, used the Equinox trade name, and used its EQUINOX Mark in commerce in connection with Opposer’s Goods and Services and filed the applications resulting in the above-identified EQUINOX Registrations prior to the filing date for Applicant’s Application.

6. The mark in Applicant’s Application is confusingly similar to Opposer’s common law EQUINOX Mark, Opposer’s Equinox trade name, and the EQUINOX Registrations.

7. Use of the mark in Applicant’s Application is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant’s services are Opposer’s Goods and Services, or are endorsed, sponsored or otherwise affiliated or connected with Opposer, or that Opposer’s Goods and Services are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

8. It has been over seven years since Applicant filed Applicant’s Application in October 2007. On information and belief, the mark is not in use in the United States, and Applicant then lacked and presently lacks a bona fide intention to use the said mark in commerce.

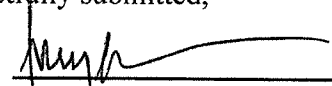
9. Granting registration to Applicant would provide Applicant with *prima facie* exclusive rights therein, and would harm Opposer by interfering with Opposer’s rights in the EQUINOX Mark, the Equinox trade name, and the EQUINOX Registrations, to Opposer’s detriment.

WHEREFORE, Opposer respectfully requests that Application Serial No. 77/305,284 be refused registration and that this opposition be sustained.

A filing fee of \$600 has been submitted electronically. If the filing fee is found to be insufficient for any reason, please charge such deficiency to our Deposit Account No. 182284.

Respectfully submitted,

By:


  
Tracy L. Zawaski  
Keith Medansky  
DLA PIPER LLP (US)  
P.O. Box 64807  
Chicago, IL 60664-0807  
Phone: 312-368-4000  
Fax: 312-236-7516

**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing Notice of Opposition was served on January 12, 2015, by first-class mail, postage prepaid, on Applicant at the following address of record:

Theodore D. Lienesch  
Thompson Hine LLP  
10050 Innovation Drive, Suite 400  
Miamisburg, Ohio 45342-4934

By:

  
Tracy L. Zawaski